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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,609	10/20/2003	Hirokazu Komai	Q77989	4685

7590 02/23/2005
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

HAUGLAND, SCOTT J

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,609

Applicant(s)

KOMAI, HIROKAZU

Examiner

Scott Haugland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The language of claim 5, line 1 and claim 6, line 1 appears inaccurate since the apparatus as disclosed cannot guarantee that there is no waste produced from the cutting of a pancake of tape.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Odaka (U.S. Patent No. 4,894,733).

Odaka discloses magnetic tape cutting-out equipment comprising: a tape supplying device (including 22), a tape winding device (including 32), a memory unit 34

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storing tape defect position data, a winding length deciding unit (see 24, 251), a cutting device 232, and a cutting control unit.

Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Karaki et al (U.S. Patent No. 6,317,951).

Karaki et al discloses an optical recording tape cutting-out equipment comprising: a tape supplying device 70, a tape winding device 22, a memory unit storing tape defect position data 344, a winding length deciding unit (within management computer 340; col. 12, line 66-col 3, line 8), a cutting device 80, and a cutting control unit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odaka in view of Pugh (U.S. Patent No. 3,569,683).

Odaka is described above.

Odaka does not disclose a winding length deciding unit that selects a first winding length if no defect is present in the length or selects another length if a defect is detected or calculates all combinations of winding lengths.

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Pugh teaches selecting a first length of material to cut when no defect is detected in the first length of material and selecting other lengths to cut if a defect is detected in the first length of material in order to minimize waste. All combinations of a set of possible lengths are calculated to determine the combination that minimizes the remaining non-defective portion of material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Odaka with a winding length deciding unit that selects a first winding length if no defect is present in the length or selects another length if a defect is detected or calculates all combinations of winding lengths as taught by Pugh to minimize waste of tape.

With regard to claim 5, it would have been obvious to calculate the ratio of used tape to the total tape on a pancake to determine the waste or yield of the machine since it well known to calculate production ratios and the like in order to monitor the efficiency of a manufacturing process.

Claims 2-5 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaki et al in view of Pugh.

Karaki et al is described above.

Karaki et al does not disclose a winding length deciding unit that selects a first winding length if no defect is present in the length or selects another length if a defect is detected or calculates all combinations of winding lengths.

Pugh teaches selecting a first length of material to cut when no defect is detected in the first length of material and selecting other lengths to cut if a defect is detected in the first length of material in order to minimize waste. All combinations of a set of possible lengths are calculated to determine the combination that minimizes the remaining non-defective portion of material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Karaki et al with a winding length deciding unit that selects a first winding length if no defect is present in the length or selects another length if a defect is detected or calculates all combinations of winding lengths as taught by Pugh to minimize waste of tape.

With regard to claim 5, it would have been obvious to calculate the ratio of used tape to the total tape on a pancake to determine the waste or yield of the machine since it well known to calculate production ratios and the like in order to monitor the efficiency of a manufacturing process.

Allowable Subject Matter

Claims 6, 12, and 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pavlenko et al is cited to show a device for calculating a

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combination of lengths into which to cut a continuous length fabric to minimize waste.

Barr et al and Blaine et al are cited to show apparatus for calculating optimal cutting positions of boards taking defects into consideration to produce a specified set of cut board lengths.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (703) 305-6498. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (703) 308-2688. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sjh
sjh
5/9/05

Kathy Matecki
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